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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,934*	12/15/2005	Aya Ono	Q92028	4074
23373 7590 08/15/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BOYKIN, TERRESSA M	
			ART UNIT 1711	PAPER NUMBER
			MAIL DATE 08/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,934

Applicant(s)

ONO ET AL.

Examiner

Terressa M. Boykin

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/5/5/68/611/6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1711

Claim Rejections - 35 USC § 102 and/or 35 U.S. C. 103(a)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by or , in the alternative, under 35 U.S. C. 103(a) over GB 1079686 see abstract and pages 1-4 as provided by applicants.

GB 1079686 discloses Iso-hexide polyesters which are obtained by condensation either with a polybasic acid or a compound giving rise to a polybasic acid. The preferred polyesters are linear and form fibers, e.g. poly(isohexide carbonate) and poly(isohexide iso-phthalate). In an example, 194 parts dimethyl terephthalate, 146 parts isosorbide and 2 parts litharge are heated together in a vapor bath at 202 deg.C. under a nitrogen atmosphere for 4 hours then raised to 222 deg.C. for 1 1/4 hours. Finally the temp. is increased to 283 deg.C. for 1 hour whilst the pressure is reduced to 1 mm. Hg. The product is a glass-like substance which can be drawn into fibers.

It is note with regard to claim 1 that the modification of the viscosity and the glass transition temperature is not unobvious and is a routine method in polycarbonate art. And thus, it would have been obvious to one of ordinary skill in the art to make such modification as needed under each particular circumstance. In fact, the change in viscosity and the glass changing temperature would be clearly expected and especially since the applicant does not show any benefit to the contrary. Note Comparative

Art Unit: 1711

example 1 which corresponds to that the reference in example 5 which demonstrates the synergistic results of combining such over that of example 13. See also claims 2-5.

Applicants claim 6 is a routine method for producing a polycarbonate. Further claims 7-10 do not contain any additional features which, in combination with the features which they refer do claim any unanticipated features. .

Thus, the reference discloses a polycarbonate prepared from the same components as claimed by applicants. Any properties or characteristics inherent in the prior art, e.g. glass transition temperature, although unobserved, unmentioned or detected by the reference, would still anticipate the claimed invention. Note In re Swinehart, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things ". *Since the disclosed amounts and parameters, temperatures, i.e. wt % etc. are expressed differently , they nevertheless appear to overlap those claimed and thus are not distinguishable over the prior art.*

As noted above, it would have been obvious to one of ordinary skill in the art to make such modification as needed under each particular circumstance. In fact, the change in viscosity and the glass changing temperature would be clearly expected and especially since the applicant does not show any benefit to the contrary. In view of the above, there appears to be no significant difference between the reference(s) and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is


Art Unit: 1711

571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (**571-272-1700**).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tmb


Examiner Terressa Boykin
Primary Examiner
Art Unit 1711